



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,483	09/19/2003	Manuel Becerra	006128/260159	4368
826	7590	11/28/2007	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			COBANOGU, DILEK B	
			ART UNIT	PAPER NUMBER
			3626	
			MAIL DATE	DELIVERY MODE
			11/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/664,483	Applicant(s) BECERRA ET AL.	
	Examiner Dilek B. Cobanoglu	Art Unit 3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 17, 19-27, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 17, 19-27, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/21/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/2007 has been entered.
2. Claims 1-9, 17, 19-27 and 29-30 remain pending in this application.

### ***Specification***

3. The new matter rejection of claims 1, 2, 4-6, 17, 23-26 has been withdrawn due to Applicant's classification on the RCE application dated 10/27/2007. Applicant has specifically pointed out that specification; page 8, line 1 to page 9, line 4 recites "customer purchases a particular item"; Applicant uses the language of "particular article of personal property" instead of "particular item", and provides a definition from [www.dictionary.com](http://www.dictionary.com) for "personal property". According to the definition provided, a personal property is "an estate or property consisting of movable articles both corporeal, as furniture or jewelry, or incorporeal, as stocks or bonds". Examiner thanks the applicant and removes the new matter rejection as well as 35 USC § 112, second paragraph rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9, 17, 19-25, 27, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. (hereinafter Becker) (U.S. Patent Publication No. 2002/0165741 A1) in view of Levison (U.S. Patent Publication No. 2002/0010599 A1).

A. As per claim 1, Becker discloses a method of providing insurance to a customer, said method comprising the steps of:

- i. selling, by a first party, a particular article of personal property to said customer (Becker; abstract, paragraph: 0013);
- ii. selling, by said first party, a service contract to said customer, said service contract providing protection against the mechanical breakdown or other failure of said article of personal property (Becker; abstract, paragraph: 0013, 0015); and
- iii. in response to said customer purchasing said service contract, providing, at no cost to said customer, insurance coverage that protects said customer against loss of said article of personal property, (Becker; abstract, paragraph: 0013, 0015), wherein: said insurance coverage is provided to at no cost to said customer due to the fact that said insurance coverage is paid for by said first party.

Becker fails to expressly teach "insurance coverage is provided to at no cost to said customer due to the fact that said insurance coverage is paid for by said first party". However, this feature is well known in the art, as evidenced by Levison.

In particular, Levison discloses "insurance coverage is provided to at no cost to said customer due to the fact that said insurance coverage is paid for by said first party" (Levison; paragraphs: 0006 and 0034).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Levison with the motivation of providing an incentive for a consumer to conduct business with a commercial enterprise (Levison; paragraph: 0006).

B. As per claim 2, Becker et al. discloses the method of claim 1, wherein said service contract provides protection against accidental damage to said item (Becker et al.; par. 0008).

C. As per claim 3, Becker et al. discloses the method of claim 1, wherein said step of providing said insurance coverage is done in order to permit the provision of said insurance coverage without its sale by an insurance agent (Becker et al.; par. 0014).

D. As per claim 4, Becker et al. discloses the method of claim 1, wherein said insurance coverage is paid for by a retailer selling said item to said customer (Becker et al.; par. 0015).

E. As per claim 5, Becker et al. discloses the method of claim 1, wherein said insurance coverage is paid for by a manufacturer of said item (Becker et al.; par. 0015).

F. As per claim 6, Becker et al. discloses the method of claim 1, wherein said insurance coverage is paid for by a service provider that provides service or functionality for said item (Becker et al.; par. 0015).

G. As per claim 7, Becker et al. discloses the method of claim 1, further comprising the step of providing said service contract and said insurance coverage to said customer within a product protection program (Becker et al.; par. 0016).

H. As per claim 8, Becker et al. discloses the method of claim 7, wherein said product protection program is referred to by a single identification indicia (Becker et al.; par. 0008 and 0013).

Examiner considers that since there is a bundled registration and loss protection service and a database that can be registered the customer and updated by the customer and/or retailer, there is a single identification indicia in the Becker et al. art.

I. As per claim 9, Becker et al. discloses the method of claim 1, wherein said service contract is provided by a first provider and said insurance coverage is provided by a second provider, said first and second providers being different entities (Becker et al.; par. 0018).

J. As per claim 17, Becker et al. discloses a unified property protection program comprising:

- i. a service contract that is paid for by a first entity, said service contract providing protection against the mechanical breakdown or failure of a particular article of personal property (Becker; paragraphs: 0008, 0013); and
- ii. insurance coverage providing protection against loss of said article of personal property, (Becker; abstract, paragraph: 0013, 0015), wherein said personal property protection program is referenced by a single identification indicia.

The obviousness of modifying the teaching of Becker to include the Insurance coverage that is paid for by a second entity (as taught by Levison) is as addressed above in the rejection of claim 1 and incorporated herein.

Examiner considers that since there is a bundled registration and loss protection service and a database that can be registered the customer and updated by the customer and/or retailer, there is a single identification indicia in the Becker.

K. As per claim 19, Becker et al. discloses the property protection program of claim 17, wherein said service contract protects against the mechanical breakdown of one or more items (Becker et al.; 0015).

L. As per claim 20, Becker et al. discloses the property protection program of claim 17, wherein said insurance coverage protects against accidental damage to said one or more items (Becker et al.; 0015).

M. As per claim 21, Becker et al. discloses the property protection program of claim 19, wherein said insurance coverage protects against a loss other than accidental damage to said one or more items (Becker et al.; 0017 and 0018).

N. As per claim 22, Becker et al. discloses the personal protection program of claim 19, wherein said insurance coverage protects against the accidental damage to, or loss of, said one or more items (Becker et al.; 0017 and 0018).

O. As per claim 23, Becker et al. discloses the property protection program of claim 17, wherein said first entity is a customer who has purchased an item that is covered by said property protection program (Becker et al.; 0018).

P. As per claim 24, Becker et al. discloses the property protection program of claim 23, wherein said second entity is a retailer that has sold said item to said customer (Becker et al.; 0018).

Q. As per claim 25, Becker et al. discloses the property protection plan of claim 23, wherein said second entity is a service provider that is to provide service or functionality for said item (Becker et al.; 0018).

R. As per claim 27, Becker et al. discloses the property protection program of claim 17, wherein said property protection program provides that: (1) in response to said second entity failing to submit timely payment for said insurance coverage, said insurance coverage will be interrupted; and (2) said service



contract will not be interrupted in response to said second entity failing to submit timely payment for said insurance coverage (Becker et al.; 0015 and 0018).

S. Claim 29 has been amended now to recite the property protection program of claim 27, wherein said product protection program provides that: (1) in response to said first entity failing to submit timely payment for said service contract, said first property coverage will be interrupted; and (2) said insurance coverage will be interrupted in response to said first entity failing to submit timely payment for said service contract (Becker et al.; 0015 and 0018).

T. As per claim 30, Becker et al. discloses the property protection program of claim 29, wherein said product protection program is referenced by a single identification indicia (Becker et al.; par. 0008 and 0013).

Examiner considers that since there is a bundled registration and loss protection service and a database that can be registered the customer and updated by the customer and/or retailer, there is a single identification indicia in the Becker et al. art.

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. (hereinafter Becker) (U.S. Patent Publication No. 2002/0165741 A1), Levison (U.S. Patent Publication No. 2002/0010599 A1) and further in view of Rydbeck (U.S. Patent No. 6,519,470).

A. As per claim 26, Becker et al. discloses the property protection plan of claim 23.

Becker et al. fails to expressly teach the second entity is a wireless carrier that provides wireless service for said item. However, this feature is well known in the art, as evidenced by Rydbeck.

In particular, Rydbeck discloses a wireless carrier that provides wireless service (Rydbeck; col. 2, lines 21-48).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Rydbeck with the motivation of manufacturers of wireless communications devices provide a time limited warranty (Rydbeck; col. 1, lines 15-17).

### ***Response to Arguments***

7. Applicant's arguments filed 10/22/2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear.

A. In response to Applicant's argument about Becker and Levinson do not teach "in response to said customer purchasing said service contract, providing, at no cost to said customer, insurance coverage that protects said customer against one or more events selected form a group consisting of: (A) loss of said article of personal property, (B) theft of said article of personal property, and (C) other named perils associated with said article of personal property, wherein said insurance coverage is provided to at no cost to said customer due to the fact that said insurance coverage is paid for by said first party"; Examiner respectfully

submits that Becker et al. teaches loss protection services for a personal property in paragraphs 0013, 0015 and also in paragraph 0017, and Levinson teaches "a retail store could provide a small insurance policy to a consumer as a bonus or "gift" in conjunction with a purchase of the retailer's product or service" in paragraph 0034.

B. In response to Applicant's argument about Becker and Levinson do not teach "a unified property protection program comprising a service contract that is paid for by a first entity, said service contract providing protection against the mechanical breakdown or failure of a particular article of personal property (Becker; paragraphs: 0008, 0013); and insurance coverage providing protection against loss of said article of personal property, (Becker; abstract, paragraph: 0013, 0015), wherein said personal property protection program is referenced by a single identification indicia."; Examiner respectfully submits that Becker et al. teaches failure of a particular article of personal property and loss protection services for a personal property in paragraphs 0013, 0015 and also in paragraph 0017, and Levinson teaches "a retail store could provide a small insurance policy to a consumer as a bonus or "gift" in conjunction with a purchase of the retailer's product or service" in paragraph 0034. The reasoning for Becker et al. teaches personal property protection program is referenced by a single identification indicia is as explained in the rejection of claims 1 and 17 above; Examiner considers that since there is a bundled registration and loss protection service and a database that can be registered the customer and updated by the

customer and/or retailer, there is a single identification indicia in the Becker et al. art.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach Method for using a smart card for recording operations, service and maintenance transactions and determining compliance of regulatory and other scheduled events 6170742 B1, Managed automobile repair and preventive maintenance system 20020010613, Apparatus and method for processing and/or for providing vehicle information and/or vehicle maintenance information 20020016655, Internet-based systems and methods for reallocating and selling used industrial equipment and machinery 20020116281, Internet based warranty and repair service 20030061104.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.


Application/Control Number:  
10/664,483  
Art Unit: 3626

Page 12

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DBC

DBC  
Art Unit 3626  
11/14/2007

  
C. LUKE GILLIGAN  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600